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09/814,214	03/22/2001	David C. Paul	8932-342	2300

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EXAMINER

CHATTOPADHYAY, URMI

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 08/07/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 18

Application Number: 09/814,214
Filing Date: March 22, 2001
Appellant(s): PAUL ET AL.

Seth A. Watkins
For Appellant

MAILED
AUG 07 2003
GROUP 3700

EXAMINER'S ANSWER

This is in response to the appeal brief filed 5/27/03.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is deficient because the embodiment described does not have the claimed limitations of a hollow body with a substantially enclosed hollow region formed between the two bone pieces.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-3, 8-13, 24 and 27-31 stand or fall together and claims 4-6, 14, 15, 25, 26 and 32-34 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,123,731	BOYCE et al.	9-2000
5,989,289	COATES et al.	11-1999
5,895,426	SCARBOROUGH et al.	4-1999
2002/0138143	GROOMS et al.	9-2002

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-3, 8-13, 24 and 27-31 are rejected under 35 U.S.C. 102(e). This rejection is set forth in prior Office Action, Paper No. 10.

Claims 4-6, 14, 15, 25, 26 and 32-34 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Action, Paper No. 10.

(11) Response to Argument

Applicant argues that in contrast to implant 800 shown in Figure 8A of Grooms et al., the exemplary embodiment of implant 1550 shown in Figure 26 of the present application comprises a top portion 1552 interlocked to a bottom portion 1554 by ridges that mate with grooves and a pin 1564 passing through aligned holes 1556 in top and bottom portions to retain the portions together. The implant can be formed with a hollow interior to form an interior space that can be filled with bone chips or other osteoconductive material.

In response, the examiner would first like to point out that the embodiment shown in Figure 26 does not itself meet the limitations of claims 1 and 27, specifically that of the implant

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comprising a hollow body with a substantially enclosed hollow region formed between the two bone pieces. The portion of the specification relied upon by applicant (page 28, lines 23-26) to support the implant being formed with a hollow interior to form an interior space is actually describing the embodiment shown in Figure 21, which is formed from a single piece of bone. The embodiment in Figure 26, in fact, cannot have a hollow interior because the top and bottom bone portions are mated together at their surfaces 1556, 1558 by complimentary ridges and grooves.

The examiner would further like to point out that no species restriction was set forth during prosecution, and it appears that applicant is not limiting the scope of claims 1 and 27 to the embodiment shown in Figure 26. For example, dependent claim 7 further limits the claimed invention to the embodiment shown in Figures 7A-7C and dependent claim 8 further limits the claimed invention to the embodiments shown in at least Figures 5A-5E. Claims 1 and 27 are therefore broad enough in scope to read on more than one embodiment, including that of Figure 4B, which implant is formed in the same fashion as that of Figure 8A of Grooms et al.

Applicant argues that Grooms et al. is silent at least with respect to “a substantially enclosed hollow region”, as required by claims 1 and 27, and that the final rejection unreasonably construes the open-ended “D” shaped key way of Grooms et al. as providing a substantially enclosed hollow region. The examiner disagrees. First, a careful review of the specification reveals that applicant neither describes in words nor points to a particular Figure to define what “a substantially enclosed hollow region” is, and therefore, the phrase is open to its broadest reasonable interpretation. For example, following the description of Figures 7A-7C on page 23, lines 16-17, “caps are optionally provided in the outermost concentric circle bone

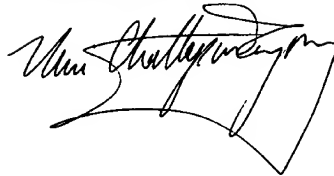
portions to form a completely-enclosed chamber within implant 1050". It is certainly a reasonable interpretation then that without the two caps (all but two sides present), a "substantially enclosed" chamber is formed within the implant rather than a "completely enclosed" chamber. Second, by claiming either a "substantially enclosed" hollow region or a "completely enclosed" hollow region, applicant makes a distinction between them. Specifically, "substantially enclosed" is broader in scope than "completely enclosed", and therefore, need not be enclosed on all sides. Following this line of reasoning, the embodiment of Figure 8A of Grooms et al. clearly teaches a "substantially enclosed" hollow region.

Applicant also argues that the construction of Figure 8A of Grooms et al. could only fall within the scope of claims 1 and 27 if the word "substantially" was allowed to negate the meaning of "enclosed hollow region". The examiner disagrees. Negation of "enclosed hollow region" would be a region that is not surrounded on any side, which is not the case here. The word "substantially" (not defined in the specification) can reasonably be interpreted to simply broaden the "enclosed region" to require only that it be surrounded on a considerable number of sides or that the all the sides enclose the region to a considerable extent. The open-ended structure of Grooms et al. meets the first interpretation.

For the above reasons, it is believed that the rejections should be sustained.

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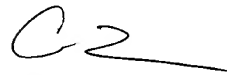
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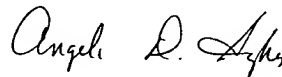
UC
August 6, 2003

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